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EXAMINER

COLBERT, ELLA

ART UNIT

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/479,918	<b>Applicant(s)</b> KLATT ET AL.	
	<b>Examiner</b> Ella Colbert	<b>Art Unit</b> 3696	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 May 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) 1-16,31 and 32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

1. Claims 1-32 are pending. Group II, claims 17-30 have been elected and claims 1-16, 31, and 32 have been withdrawn without traverse in this communication filed 5/13/08 entered as Response to Election/Restriction and Request for Extension of Time. Claims 17-30 will be examined on the merits as set forth here below.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 17 and 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 17 recites "database monitor" and as written the claim language is vague and varied making the limitation indefinite. A person reading this claim limitation would interpret it as a database with a monitor (computer screen). The specification recites "a monitoring function" for monitoring database changes and to be configured to watch for changes to a particular field or tables of a corporate database or to be configured to generate event data when a change occurs to the database as described on page 8, line 21-pg. 9, line 2 and lines 13-19. "A database monitoring function" recited in the claim limitations would make the claim language clear. ***Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See In re Van Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).***

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 17-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 5,563,999) Yaksich et al, hereafter Yaksich in view of (US 6,330,542) Sevcik et al, hereafter Sevcik.

With respect to claim 17, Yaksich discloses, a computer-implemented database monitor located at a corporate facility, wherein the database monitor detects changes to the corporate sales management system and, in response thereto, generates event data comprising information that describes the sales management event (col. 5, lines 30-61). Yaksich failed to disclose, a print processing facility, located at a geographic location different from the corporate location and coupled to the database monitor over a network, wherein the print processing facility receives the event data, compares the event data to one or more predefined event rules that determine whether the printed product should be produced and, in response to a positive determination, automatically generates a print order for the printed product using information extracted from the event data. Sevcik discloses, a print processing facility, located at a geographic location different from the corporate location and coupled to the database monitor over a network, wherein the print processing facility receives the event data, compares the event data to one or more predefined event rules that determine whether the printed

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product should be produced and, in response to a positive determination, automatically generates a print order for the printed product using information extracted from the event data (col. 1, lines 11-22, col. 3, lines 42-65, col. 6, lines 28-67, and col. 7, lines 1-2). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Yaksich with the teachings of Sevcik in view of Yaksich's manufacturing (printing) facility at a number of geographically remote locations and because such a modification would allow Yaksich to manage commercial printing and the inefficiencies that exist for both the buyers of commercial printing and the providers (see Sevcik - col. 1, lines 8-16).

With respect to claim 18, Yaksich failed to disclose, The system of claim 17, wherein the print order comprises a procurement request that requires further approval by a corporate employee before the printed product is produced. Sevcik discloses, wherein the print order comprises a procurement request that requires further approval by a corporate employee before the printed product is produced (col. 1, lines 11-22, col. 3, lines 42-65, and col. 6, lines 28-67-col. 7, line 2). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Yaksich with the teachings of Sevcik because such a modification would allow Yaksich to understand the significance of receiving an immediate quote computed from various print providers, to consider the process involved, the transaction costs to the organization, and the steps that are apart of the process before the printed product is produced.

With respect to claim 19, Yaksich discloses, The system of claim 17, wherein the procurement request is approved in a procurement system located at the corporate

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facility, and wherein the print processing facility transmits the procurement request to the procurement system for approval by the corporate employee (col. 8, lines 28-34, col. 9, line 1-col. 11, line 39 and col. 39, lines 39-42).

With respect to 20, Yaksich discloses, The system of claim 19, wherein the procurement system transmits the approval to the print processing facility which, in response thereto, produces the printed product (col. 39, lines 39-42).

With respect to 21, Yaksich discloses, The system of claim 17, wherein the print order comprises a print production request that is directly fulfilled by a print production system without further approvals (col. 40, line 65-col. 41, line 7)..

With respect to claim 22, Yaksich teaches, wherein the print order comprises one or more print criteria that must be satisfied before the printed product is actually produced (col. 9 and 10, lines 25-67 and col. 11, lines 1-15).

With respect to claim 23, Yaksich failed to disclose, wherein the print processing facility notifies a corporate employee via e-mail of the print order. Sevcik discloses, wherein the print processing facility notifies a corporate employee via e-mail of the print order (col. 15, lines 13-25). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify in Yaksich with the teachings of Sevcik because such a modification would allow Yaksich to have the capability to have the delivery service send the image to the client for approval and the client can contact the system by electronic mail to confirm approval of the order (notification of the print order to the client (employee) via e-mail).

With respect to claim 24, Yaksich failed to disclose, wherein the corporate employee is

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specified in one of the predefined event rules. Sevcik discloses, wherein the corporate employee is specified in one of the predefined event rules (col. 16, lines 4-22). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify in Yaksich with the teachings of Sevcik because such a modification would allow Yaksich to have a confirmation from the client (corporate employee) as to the approval to execute the order in full according to the description in the client's order (predefined event rules).

With respect to claim 25, Yaksich failed to disclose, The system of claim 17, wherein the database monitor and the print processing facility communicate over the Internet. Sevcik discloses, The system of claim 17, wherein the database monitor and the print processing facility communicate over the Internet 9col. 3, lines 22-41). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify in Yaksich with the teachings of Sevcik because such a modification would allow Yaksich to have an automated Internet system that features a series of graphical interfaces which represent various print providers and to have the optimal equipment for the project to be computed and for the project to be produced.

With respect to claim 26, Yaksich failed to disclose, The system of claim 17, wherein the print processing facility retrieves corporate- specific information in addition to the event data and uses the corporate-specific information to generate a print production request. Sevcik discloses, The system of claim 17, wherein the print processing facility retrieves corporate- specific information in addition to the event data and uses the corporate-specific information to generate a print production request (col. 3, line 42-col. 4, line 11).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify in Yaksich with the teachings of Sevcik because such a modification would allow Yaksich to have a system that has a complete database of information for custom products which allows for search and retrieval of specific information and automatically generates quotes for custom products and ensures the project is produced on the equipment for that particular product.

Claims 27-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 5,563,999) Yaksich et al, hereafter Yaksich in view of (US 6,330,542) Sevcik et al, hereafter Sevcik and further in view of IPrint.com.

With respect to claim 27, Yaksich and Sevcik failed to disclose, The system of claim 26, wherein the corporate-specific information comprises a corporate logo that is not stored in the corporate sales management system. IPrint.com discloses, The system of claim 26, wherein the corporate-specific information comprises a corporate logo that is not stored in the corporate sales management system (Pg. 7, para. 3, Pg. 8, para. 2 and Pg. 9, para. 1). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify in Yaksich with the teachings of IPrint.com because such a modification would allow Yaksich to have the information that is entered to become part of the database for that item (the item could be a corporate logo).

With respect to claim 28, Yaksich failed to disclose, The system of claim 17, wherein the print processing facility generates a print production request to produce the printed product without any human intervention at the corporate facility and without any human



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intervention at the print production facility. Sevcik discloses, The system of claim 17, wherein the print processing facility generates a print production request to produce the printed product without any human intervention at the corporate facility and without any human intervention at the print production facility (col. 9, lines 26-64). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify in Yaksich with the teachings of Sevcik because such a modification would allow Yaksich to have a system with a home page that includes all of the information that a print buyer needs in order to send a print production job over the Internet from a corporate facility to a print production facility.

With respect to claim 29, Yaksich discloses, The system of claim 17, wherein the print processing facility translates at least some of the event data into a common print production request based on a schema mapping between fields in the corporate human resources database and fields stored in the print processing facility (col. 11, lines 30-39 and col. 13, line 1-col. 16, line 55).

With respect to claim 30, Yaksich failed to disclose, The system of claim 17, wherein the printed product comprises a sales brochure. Sevcik discloses, The system of claim 17, wherein the printed product comprises a sales brochure (col. 7, lines 3-12). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify in Yaksich with the teachings of Sevcik because such a modification would allow Yaksich to have what is known as marketing collateral which includes sales and data sheets and brochures (sales literature).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Zingher (US 5,897,260) disclosed print job allocation interlinks for customers of a plurality of printing plants located throughout the world.

McDonald (US 5,327,265) disclosed an image database for on-demand printing.

Tackbary et al (US 5,555,496) disclosed the distribution for management, selection and delivery of social expression cards.

Morimoto (US 5,340,966) disclosed a device for automatically receiving facsimile information transmitted from an order.

Thompson et al (US 6,810,401) disclosed an automated configuration system (and method) for facilitating the configuration of desired products, services, or other assemblages that require users to gather and assimilate desired products/services.

### **Inquiries**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The examiner can normally be reached on Monday, Tuesday, and Thursday, 5:30AM-3:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dixon Thomas can be reached on 571-272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ella Colbert/  
Primary Examiner, Art Unit 3696

August 4, 2008